



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/855,989 | 05/15/2001 | Edward D. Brill | 2206.64630 | 9366 |

24978 7590 06/03/2005

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER

PRONE, JASON D

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3724

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,989

Applicant(s)

BRILL ET AL.

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/5/05 & 5/13/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 7, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Soultanian (6,163,092).

'092 discloses the invention including a stationary piece (10) having a plurality of laminations (38), a moving piece (12) having a plurality of laminations (40), the moving piece is hingedly secured to the stationary piece by interlocking the moving piece laminations directly with the stationary piece laminations (20), an electric coil (14), a movement control system connected to the stationary piece and the moving piece (32) having at least one spring (22) and at least one device for adjusting the tension (34), the coil is on the stationary piece (Fig. 2), a driver (24) crimped to the moving piece (18) for connection to a motor load (26), a hinge holder having a first surface that retains the moving piece axially while still allowing the moving piece to rotate (Fig. 2), a coil bobbin (16) on the stationary piece around which the coil is wound (Fig. 1), the coil bobbin also has an extension to which the movement control system is connected to (30), the

movement control system is connected to the driver (Fig. 1), and a low friction insert between the stationary and moving pieces where they are hinged (20).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over '092 in view of WO 00/27599. '092 discloses the invention but fails to disclose a hinge holder having a second surface that biases the moving piece radially while still allowing the moving piece to rotate. WO 00/27599 teaches of a hinge holder having a second surface that biases the moving piece radially while still allowing the moving piece to rotate (22). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided '092 with a hinge holder having a second surface, as taught by WO 00/27599, to bias the moving piece radially while still allowing the moving piece to rotate.

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over '092. '092 discloses the invention including that the circular shaped end fits inside the circular shaped opening (Fig. 6) and the movement control system is located at a second end of the moving piece (Fig. 12) but fails to disclose that the stationary piece has the circular shape at a first end and the moving piece forms the circular shaped opening at a first end. It would have been obvious to one having ordinary skill in the art

Art Unit: 3724

at the time the invention was made to switch the circular shaped end and the circular shaped opening, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over '092 in view of Davis. '092 discloses the invention including that the movement control system includes a screw (34) having threads and a head (Fig. 1) but fails to disclose the screw being adjustably threaded in an opening in the stationary piece, the screw passes freely through an opening in the moving piece, the stationary piece opening is located on one side of the moving piece opening and the screw head is located on the other side of the moving piece opening, a first spring between the stationary and moving pieces, and a second spring between the moving piece and the screw head. Davis teaches a screw (46) being adjustably threaded in an opening in the stationary piece (40), the screw passes freely through an opening in the moving piece (41), the stationary piece opening is located on one side of the moving piece opening and the screw head is located on the other side of the moving piece opening (Fig. 2), a first spring between the stationary and moving pieces (50), and a second spring between the moving piece and the screw head (Fig. 2). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided '092 with the movement control system characteristics, as taught by Davis, to allow for a more precise adjustment.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over '092 in view of Huppert, Sr. '092 discloses the invention but fails to disclose at least one grease channel in the hinge. Huppert, Sr. teaches a grease channel (8) in a hinged

structure (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided '092 with a grease channel, as taught by Huppert, Sr., to allow for a smoother hinged surface.

8. Claims 17, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over '092 in view of Wahl et al. (5,787,587). '092 discloses the invention including a stationary piece (10) having a plurality of laminations (38) and a coil (14), a moving piece (12) having a plurality of laminations (40), the moving piece is hinged to the stationary piece at one end by interlocking the moving piece laminations directly with the stationary piece laminations (20), a driver (24) at another end of the moving piece (Fig. 2), a movement control system connected to the stationary piece and the moving piece (32) having at least one spring (22) and at least one device for adjusting the tension (34), a hinge holder having a first surface that retains the moving piece axially while still allowing the moving piece to rotate (Fig. 2), a coil bobbin (16) on the stationary piece around which the coil is wound (Fig. 1), and the coil bobbin also has an extension to which the movement control system is connected to (30).

However, '092 fails to disclose a case having at least one attachment point for securing the motor, a stationary blade, a moving blade adapted for reciprocation across the moving blade, a motor secured to the case at the attachment point, the driver and the moving blade are coupled for movement of the moving blade, the stationary piece and the moving piece have a plurality of laminations and a hinge made of interlocking laminations of the stationary and moving pieces. '587 teaches a case having at least one attachment point for securing the motor (Fig. 1), a stationary blade (104), a moving

Art Unit: 3724

blade (122) adapted for reciprocation across the moving blade (A), a motor secured to the case at the attachment point (Fig. 1), and the driver and the moving blade are coupled for movement of the moving blade (120). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided '092 with hair clipper components, as taught by '587, to allow for use as a hair clipper.

9. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over '092 in view of '587 as applied to claims 17 and 18 above, and further in view of WO 00/27599. '092 and '587 disclose the invention but fail to disclose a hinge holder having a second surface that biases the moving piece radially while still allowing the moving piece to rotate. WO 00/27599 teaches a hinge holder having a second surface that biases the moving piece radially while still allowing the moving piece to rotate (22). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided '092 in view of '587 with a hinge holder having a second surface, as taught by WO 00/27599, to bias the moving piece radially while still allowing the moving piece to rotate.

Response to Arguments

10. Applicant's arguments filed 25 January 2005 have been fully considered but they are not persuasive. Applicant argues that the claim language of the phrases "the moving piece being hingedly secured to the stationary piece by interlocking the moving piece laminations directly with the stationary piece laminations", of claim 1, and "the moving piece being hinged to the stationary piece at one end by interlocking the moving

Art Unit: 3724

piece laminations directly with the stationary piece laminations", of claim 17, is not disclosed by the Soultanian '092 patent.

in·ter·lock (inˈter-lɒk) *verb*

in·ter·locked, in·ter·lock·ing, in·ter·locks *verb, transitive*

1. To unite or join closely.
2. To connect together (parts of a mechanism, for example) so that the motion or operation of individual parts affect each other.¹

In view of statement that "Hinging can be accomplished in many ways" (page 8 line 6 of the specification) and the definition of "interlocking", the Soultanian '092 patent clearly discloses that the moving piece laminations are hingedly interlocked/joined closely with the stationary piece laminations. The moving piece (12) is directly "joined closely" to the stationary piece by hinge (20). Applicant is arguing the term "directly". It is noted that the term "directly" is not defined in the specification to exclude the definition cited by the examiner. In addition, to the extent that applicant was attempting to entertain a pivoting connection without an additional interconnecting member, it is noted that these structures are old as shown by the U.S. patent to Stettler (6,493,905). However, applicant's claims are not yet providing limitations that limit the claims to such a structure.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

¹ *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 571-272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 3724

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP
May 25, 2005



Allan N. Shoap
Supervisory Patent Examiner
Group 3700